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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/554,451	05/15/2000	JONATHAN P MURPHY	PM-268066	2087

909 7590 06/18/2002
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EXAMINER

SISSON, BRADLEY L

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 06/18/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/554,451

Applicant(s)

MURPHY ET AL.

Examiner

Bradley L. Sisson

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 May 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See remarks under Section 5, below.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-12 and 27.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Bradley L. Sisson
Primary Examiner
Art Unit: 1634

Continuation of 5. does NOT place the application in condition for allowance because: The aspect of limiting the claims to a method whereby one is to distinguish between exogenously administered and endogenous polypeptides as proposed would result in difficulties when the exogenously administered polypeptide fluoresces at the same wavelength as does the endogenous polypeptide. By not knowing the original endogenous polypeptide concentration, and not being able to differentiate between the exogenous and endogenous polypeptide based upon differences in signal, not just signal intensity, one would not be able to readily detect the presence of the molecule of interest. The proposed claims may also fairly raise issues of written description in that the specification does not reasonably suggest that applicant was in possession of a method whereby not only were the exogenously administered compounds to be fluorescent, but that they had also undergone centrifugation, affinity chromatography, immunoaffinity chromatography, denaturation and/or heat treatment. A review of the disclosure has been found to contain eight prophetic examples. While such treatment programs are suggested at page 16, the disclosure is essentially silent as to how the genera of compounds are to be treated individually and then formulated into a useful composition that would in turn be useful and predictable in the now claimed method. At best applicant has provided suggestions as to how the compounds and compositions are to be made and used, relying upon those of skill in the art to provide the missing details. While one may argue that the resolution of these issues may be obvious to one of skill in the art at the time of filing, the aspects of an invention being obvious does not in and of itself satisfy the written description requirement. In support of this position, attention is directed to the decision in *University of California v. Eli Lilly and Co.* 43 USPQ2d at 1405, citing *Lockwood* 41 USPQ2d at 1966:

Recently, we held that a description which renders obvious a claimed invention is not sufficient to satisfy the written description requirement of that invention.

Accordingly, and in the absence of convincing evidence to the contrary, the proposed amendment is considered to fairly raise issues of enablement and written description under 35 USC 112, first paragraph.